

### **REMARKS**

Applicants request consideration in view of the following remarks and in view of the above amendments.

1. **Status of the Claims**

The status of the claims upon entry of the present amendments stands as follows:

**Pending Claims:** 1-15

**Rejected Claims:** 1-15

**Allowed Claims:** None

**Objected to Claims:** None

**Withdrawn Claims:** None

2. **Support for the Amendments**

Applicants amend claims 10, 12, and 14 to more precisely recite the claimed subject matter. Support for the amendments of claims 10, 12, and 14 can be found at least from originally filed claims.

The claims have been amended without prejudice to, or disclaimer of, the canceled subject matter. Applicants reserve the right to file a continuation or divisional application on any subject matter canceled by way of amendment.

3. **Priority Documents**

Applicants appreciate the Office's acknowledgement for foreign priority. The Office, however, does not specify in the Office Action Summary which category of priority documents has been received. Clarification of record is respectfully requested with the Office's next communication.

4. **Information Disclosure Statements**

Applicants appreciate the Office's acknowledgement of the Information Disclosure Statement (IDS) submitted February 29, 2008.

**5. Rejections Under 35 U.S.C. § 112, Second Paragraph**

The Office rejects claims 10, 12, and 14 under 35 U.S.C. § 112, second paragraph, as allegedly indefinite. The Office alleges that the recitation of “allowing” renders claims 10, 12, and 14 indefinite. Office Action, ¶ 3. The Office further alleges that the recitation of “a carbonic acid” renders claim 14 indefinite. *Id.*

Without acquiescing to the merits of the Office rejection, Applicants amend claims 10, 12, and 14. The phrases “allowing” and “a carbonic acid” no longer occur in the amended claims. The rejections are thus moot. Applicants respectfully request withdrawal of the rejection and allowance of the claims.

**6. Rejection of the Claims Under 35 U.S.C. § 103(a)**

**6.1. Claims 1-6, 9-13, and 15**

The Office rejects claims 1-6, 9-13, and 15 under 35 U.S.C. § 103(a) as allegedly unpatentable over **Suntory News Release No. 8691** (“Suntory8691”) in view of **Herraiz et al.**, 38 J. AGRIC. FOOD CHEM. 1540 (1990) (“Herraiz”).

Suntory8691 allegedly teaches Macadia, which is “a liquor product wherein maca and rose hip are infused in Andes white grape distilled spirits and finished with lime and lemon juice.” Office Action, ¶ 7. The Office admits that Suntory8691 does not teach using Muscat grapes and the acetic acid content. *Id.* The Office apparently applies Herraiz to cure the defect. Herraiz allegedly teaches that Pisco (a wine distillate made from Muscat grapes) contains 100 ppm of acetic acid per pure alcohol. *Id.* The Office thus alleges that a skilled artisan would have been motivated to use Muscat grapes for Macadia. *Id.* As to claim 2, the Office alleges that the claimed volume range of maca extract can be obtained by routine optimization. *Id.* As to claims 9-13 and 15, the Office alleges that the combination of Suntory8691 and Herraiz would “naturally” produce an odor-decreasing effect. *Id.* The Office admits that the rejection relies upon an “oral translation” of Suntory8691. *Id.*, at 6, ¶ 10.

Applicants traverse. “[O]bviousness requires a suggestion of *all* limitations in a claim.” *CFMT, Inc. v. Yieldup Int’l Corp.*, 349 F.3d 1333, 1342, 68 U.S.P.Q.2d 1940, 1947 (Fed. Cir. 2003) (citing *In re Royka*, 490 F.2d 981, 985, 180 U.S.P.Q. 580, 583 (C.C.P.A. 1974) (emphasis added)). Furthermore, one element of *prima facie* obviousness is whether a skilled artisan would have had reasonable expectation of success to practice the claimed invention. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). To establish *prima facie* obviousness using a combination of multiple references, the Office must show that the combination or modification must have expected and predictable results. *See* M.P.E.P. § 2143. The Office fails to provide and demonstrate a rationale that would yield predictable results.

It is known in the art that “maca liquor consumed in the Andes region does not suit the taste of modern people due to a distinct odor of maca.” *See* Specification, lines 19-20 on page 2. It is Applicants’ objective to “provide an alcoholic beverage containing an extract of maca having various excellent properties, which has less odor of extract of maca, and is easy to drink.” *See* Specification, lines 27-30 on page 2. Applicants first identified a method of masking the distinctive odor of maca extract by using the distilled liquor made from fermented Muscat grapes as a base alcohol. *See e.g.*, Specification, paragraph bridging pages 2-3. “Such a masking effect is specific to the distilled liquor mainly made from fermented Muscat grapes, and cannot be achieved by other distilled liquors, brandy, or whiskey.” *See* Specification, paragraph bridging pages 5-6; Example 2. Furthermore, Applicants determined that the distilled liquor must contain acetic acid in a certain range to result in a beverage having both decreased maca odor and improved drinkability. *See e.g.*, Specification, lines 7-21 on page 6; Table 2, Example 3; and lines 3-12 on page 13.<sup>1</sup> Given at least these findings, claim 1 recites a maca extract-containing alcoholic beverage. The claimed beverage is pleasant to drink, because the distinctive odor of maca is masked or minimized. *See e.g.*, Specification, first full paragraph on page 5.

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<sup>1</sup> “As shown in Table 2, as the maca extract content was increased, the odor of maca became stronger. Further, by adding acetic acid in such a manner that an acetic acid content became 1 ppm or more, the odor of maca was significantly masked. However, in the case where the acetic acid content was more than 400 ppm, ease of drinking was impaired. On the other hand, in the case where the acetic acid content was less than 1 ppm (that is, in the case of the distilled liquor containing 0.5 ppm of acetic acid or in the case of alcohol for brewing as a control), the effect of masking the odor of maca was not confirmed.”

Independent claims 9 and 15 describe methods of making maca extract-containing beverages having decreased maca odor. *See e.g.*, the paragraph bridging pages 4-5.

The Office's rejection is unsupported, because the combined references fail to provide evidence to support the Office's allegation that the combination would have been expected and predictable. Suntory8691 does not mention the odor of maca extracts, let alone suggest a means of masking or minimizing the odor. At best, Suntory8691 teaches "a liquor product wherein maca and rose hip are infused in Andes white grape distilled spirits and finished with lime and lemon juice." Herraiz does not mention maca extracts at all, let alone their odor. Herraiz teaches using a multidimensional system to analyze Pisco, an alcoholic beverage "which is obtained by distillation of wine made from Muscat grapes." *See* Herraiz, page 1540. Thus, the two references relied upon by the Office address entirely different problems using different methods and materials. There is no guidance provided by either reference to solve the current problem—developing a maca-containing alcoholic beverage with reduced or eliminated maca odor. Accordingly, a skilled artisan would not have been lead to combine these references, let alone have expected predictable results from the alleged combination.

The Office attempts to justify the combination of references by arguing that Pisco is "a high-quality product." Office Action, ¶ 7. This statement is inaccurate, given the context of the following paragraph as a whole:

Pisco is a common drink, originating in some South American countries, which is obtained by distillation of whine made from Muscat grapes. It is considered a high-quality product and a factor of important economical repercussion. *However, no definitive rules have been established concerning its elaboration, and consequently, the alcohol content of Pisco as well as its volatile composition may vary broadly. As a result, the introduction of this beverage into the international market has been quite hindered.*

*See* Herraiz, page 1540 (emphasis added; internal citations omitted). Accordingly, Pisco's quality varies greatly. As discussed above, the Office must provide evidence or a rationale of why a skilled artisan would have had some apparent reason to replace a known component in a way that would result in the presently claimed products and methods. *See e.g. Ex parte Whalen*, 89 U.S.P.Q.2d 1078, 1084 (Bd. Pat. App. & Int. 2008) (precedential). The Office failed to provide evidence or reasoning that a skilled artisan would have had some apparent reason to

replace “Andes white grape distilled spirits” of Suntory8691 with Pisco, let alone that such a replacement would have resulted in decreased or eliminated maca odor.

The only way the Office appears to achieve combining the elements from the references is through the hindsight roadmap presented by Applicants’ own specification. The Office cannot pick and choose between all the options and teachings presented by each of the references to arrive at the combination of limitations as presented in the claims. *See e.g., AKZO N.V. v. United States Int’l Trade Comm’n*, 808 F.2d 1471, 1781, 1 U.S.P.Q.2d 1241, 1246 (Fed. Cir. 1986) (one “cannot pick and choose among individual parts of assorted prior art references as a mosaic to recreate a facsimile of the claimed invention.”).

In view of above arguments, claims 1, 9, and 15 are nonobvious over cited references. Dependent claims 2-6 and 10-13 are likewise nonobvious. Accordingly, Applicants respectfully request withdrawal of the rejection and allowance of the claims.

## 6.2. Claim 7

The Office rejects claim 7 under 35 U.S.C. § 103(a) as allegedly unpatentable over **Suntory8691** in view of **Herraiz**, and further in view of **Ogawa** et al. JP 2004-000171 (“Ogawa”). Ogawa allegedly teaches extracting maca with ethanol at 25°C or 40°C. Office Action, page 5, ¶ 8 The Office alleges that a skilled artisan would have been motivated to incorporate Ogawa’s maca extract into Macadia. *Id.*

Applicants traverse. Suntory8691 and Herrera fail to render claim 1 obvious for reasons discussed in Section 6.1. *supra*. Claim 7 depends directly from claim 1. Therefore, claim 7 is at least nonobvious for the reasons asserted *supra*. Claim 7 further recites, *inter alia*, obtaining the maca extract “by adding an ethanol-containing aqueous solution to pulverized maca to carry out extraction at 20 to 75°C.” The addition of Ogawa to Suntory8691 and Herrera does not cure the defects of Suntory8691 and Herrera as discussed in Section 6.1. *supra*. Ogawa is relied upon for allegedly teaching maca extraction with ethanol at 25°C or 40°C. However, Ogawa does not teach at least masking or minimizing maca odor. Also, the Office fails to justify that the combination of the cited references would have yielded predictable results to solve the present problem—developing a maca-containing alcoholic beverage with reduced or eliminated maca

odor. *See* Section 6.1. *supra*. None of the references in fact addresses the problem currently solved. Accordingly, a skilled artisan, in view of the combination of the three cited references, would not have had a reasonable expectation of success that the presently claimed beverage would have been made. The combination of Suntory8691, Herraiz, and Ogawa thus fail to render claim 7 obviousness.

Thus, claim 7 is nonobvious over cited references. Applicants respectfully request withdrawal of the rejection and allowance of claim 7.

### 6.3. Claims 8 and 14

The Office rejects claims 8 and 14 under 35 U.S.C. § 103(a) as allegedly unpatentable over **Suntory8691** in view of **Herraiz**, and further in view of **Gonzales** et al., U.S. Published Patent Application No. 2006/0147600 (“Gonzales”). Gonzales alleges teaches a carbonated beverage containing maca. Office Action, pages 5-6, ¶ 9. The Office alleges that a skilled artisan would have been motivated to make Macadia a carbonated beverage. *Id.*

Applicants traverse. Suntory8691 and Herraiz fail to render claims 1 and 9 obvious for reasons discussed in Section 6.1. *supra*. Claims 8 and 14 depend directly from claim 1 and claim 9, respectively. Therefore, claims 8 and 14 are at least nonobvious for the reasons asserted *supra*. Claims 8 and 14 further recite, *inter alia*, that the claimed maca extract-containing beverage is a carbonated beverage. The addition of Gonzales to Suntory8691 and Herraiz does not cure the defects of Suntory8691 and Herraiz as discussed in Section 6.1. *supra*. Gonzales is relied upon for allegedly teaching a carbonated beverage containing maca. However, Gonzales does not teach at least masking or minimizing maca odor. The Office fails to provide a rationale on how the cited references would have yielded predictable results to solve the present problem—developing a maca-containing alcoholic beverage with reduced or eliminated maca odor. *See* Section 6.1. *supra*. None of the references in fact addresses the problem currently solved. Accordingly, a skilled artisan, in view of the combination of the three cited references, would not have had a reasonable expectation of success that the presently claimed beverage would have been made and/or the presently claimed methods would have worked. The

combination of Suntory8691, Herraiz, and Gonzales thus fail to render claims 8 and 14 obviousness.

Thus, claims 8 and 14 are nonobvious over cited references. Applicants respectfully request withdrawal of the rejection and allowance of the claims.

### **CONCLUSION**

Should the Examiner have any questions or comments regarding Applicants' amendments or response, she is asked to contact Applicants' undersigned representative at (202) 842-8821. Please direct all correspondence to the below-listed address.

In the event that the Office believes that there are fees outstanding in the above-referenced matter and for purposes of maintaining pendency of the application, the Office is authorized to charge the outstanding fees to Deposit Account No. 50-0573. The Office is likewise authorized to credit any overpayment to the same Deposit Account Number.

Respectfully Submitted,

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By. 

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